

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: MASAFUMI SHIMODAIRA, HIROYUKI ODA,
YASUHIKO KOBAYASHI AND AKIRA ONIKUBO

Application No. 10/783,107

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on October 3, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matter requiring attention prior to docketing is identified below.

EXAMINER'S ANSWER

NEW GROUND OF REJECTION

On April 19, 2007, an Examiner's Answer was mailed. The Examiner's Answer included a new ground of rejection, where Claim 4 was rejected under 35 U.S.C. § 102(e) as anticipated by Watanabe, U.S. Patent Application Publication 2003/0051848. It is revealed that Claim 4 was rejected under 35 U.S.C. 103(a) as being unpatentable over Eklund in view of WO '558 as applied to claims 1-2, 5-8 above, and further in view of Gulya et al. U.S. Patent No. 5,071,697 in the Final Rejection mailed April 10, 2006. Although the Examiner's Answer (pgs.



Application No. 10/783,107

2-3) withdrew the rejection “claims 3-4 over Eklund in view of WO ‘558...” and corrected the incorrect claim numbering (pg, 4). However, the Appeal Brief is appealing claims 2 and 3 under 102(e) as opposed to claims 3 and 4 under 102(e).

When a new ground of rejection is introduced in the Examiner’s Answer, the Examiner is required to obtain approval of the Technology Center Director or his/her designee. Further, any new ground of rejection is required to be prominently identified, eg., a separate heading with all capitalized letters. See MPEP § 1207.02(A)(6)(d).

To correct this problem, the examiner will need to vacate the Examiner’s Answer mailed April 19, 2007, and mail a Supplemental Examiner’s Answer with the approval of the Technology Center Director or designee.

Application No. 10/783,107


CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) issue and mail a revised Examiner's Answer, clarifying and properly identifying any new grounds of rejection and
- 2) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

By: 
PATRICK J. NOLAN
Deputy Chief Appeals Administrator
(571) 272-9797

PJN/tsj

cc: HOWSON AND HOWSON
501 OFFICE CENTER DRIVE
SUITE 210
FT WASHINGTON, PA 19034